UNITED STATES DISTRICT COURT
DISTRICT OF NEW JERSEY
(609) 989-2040

CHAMBERS OF
TONIANNE J. BONGIOVANNI
UNITED STATES MAGISTRATE JUDGE

U.S. COURTHOUSE
402 E. STATE STREET, RM 6052
TRENTON, NJ 08608

August 7, 2008

LETTER ORDER ON ORAL MOTION

Re: MEDEVA PHARMA SUISSE A.G. et al v. ROXANE LABORATORIES, INC.
Civil Action No. 07-5165 (FLW)

Dear Counsel:

The Court has received and reviewed your recent correspondence in the above matter regarding (1) production of product samples from Defendant and (2) Plaintiff's informal motion to disqualify Defendant's proposed expert Dr. Alan Safdi.[1]

With regard to the first issue, Plaintiff argues that "Roxane put its product at issue by asserting in its Paragraph IV Certification that its proposed generic product does not infringe the claims" of the patent in issue." Specifically, Plaintiff asserts that Plaintiff "should not be permitted to assert or imply that its product is not within the claims of the patent, but then deny Plaintiffs the opportunity to test those assertions." For its part, Defendant "objects to providing samples of its expired drug product unless [Plaintiff] assures Roxane that the samples will not be used in any sort of testing on human subjects."

The Court finds that the production requested by Plaintiff is appropriate. However, in light of Defendant's assertions that the samples are expired, Plaintiff is hereby precluded from conducting any human testing with the samples, unless it first seeks and attains prior Court approval. Defendant shall produce its product samples to Plaintiff by **August 20, 2008**.

The Court further finds that the submissions regarding the issue of Dr. Safdi's possible disqualification are incomplete. As the parties are aware, in determining whether an expert who had a prior relationship with a party should be disqualified, a court must make two initial factual determinations. *Cordy v. Sherwin Williams Co.*, 156 F.R.D. 575, 579 (D.N.J. 1994). First, it must find that is was "objectively reasonable for the first party who retained the expert to believe that a confidential relationship existed." *U.S.* ex rel. *Cherry Hill Convalescent v. Healthcare Rehab Sys*., 994 F.Supp. 244, 249 (D.N.J. 1997); *see also Cordy*, 156 F.R.D. at 579. Second, the Court must find that the first party did in fact disclose confidential information to the proposed expert, where "confidential information" is information subject to actual confidentiality agreements between the proposed expert and the party seeking exclusion. *Id.*

[1] The Court applauds the successful efforts of counsel to meet, confer, and resolve the third issue raised, regarding document production. (*See* Theodora McCormick's August 5, 2008 Letter to the Court). As the parties agreed, Plaintiff shall substantially complete its document production by **September 30, 2008**.

Reserving Its opinion of whether the first prong has been met, the Court requires an *ex parte* certification from Plaintiff outlining precisely what information was disclosed to Dr. Safdi, why that information is confidential, and how that information is not now in the public domain. To that end, counsel should refer to and attach unredacted copies of the slides attached at Exhibit D to their June 27, 2008 letter brief, as well as any other written materials provided to or shared with Dr. Safdi that support Plaintiff's argument. This certification shall be produced for *in camera* review no later than **August 20, 2008**.

IT IS SO ORDERED.

s/ Tonianne J. Bongiovanni
TONIANNE J. BONGIOVANNI
United States Magistrate Judge